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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,881	06/05/2000	Mordhay Barkan		8240

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EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
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3692

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/586,881	Applicant(s) BARKAN, MORDHAY	
	Examiner Harish T. Dass	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to applicant's communication (amendment) on 08/27/2007.

Status of Claims:

Claims 1-34 are canceled.

Claims 34-47 are pending

Claim Objections

1. Claims 35 and 41 are objected to because of the following informalities: Claim 35 and claim 41 contains parentheses, which do not meet the requirements of 37 CFR 1.121 or 1.4. Parentheses are allowed only in specification reference to the drawing item. In order for the amendment document to be compliant, correction of the claims are required. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 35 line 11 state "no exchange of digital tokens" is not found

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in original specification. Even applicant states that in remarks that no new matter is added, please provide support for this limitation or correct the claims to read as described in specification.

Similarly claim 41 lines 5-6 has similar limitation. In future communication (amendment) provide the pages and support for changes.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 35-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 line 11 "there is no exchange of digital tokens between the user and the third party" is not clear. On what bases the third party provides service if he/she is not paid based on the objective of the invention?

Based on examiner's understanding of the claimed limitations, the user is a "1st party", the issuer is "2nd party" and service provider (merchant, vendor) is a "3rd party". Digital tokens are issued (sold) by 2nd party to the 1st party (user) when merchant is not part of discussion or communication. 1st party makes purchase service from 3rd party and using tokens to pay for service and tokens are canceled after use. User has to provide (enter in computer) the serial number of token number, like providing check account or credit card account, to merchant, otherwise how the merchant provides a service?

Similarly claim 41 lines 5-6 has similar limitation.

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Claims 35-47 are rejected under 35 U.S.C. 112, second paragraph,

Claim 35 recites the limitation " digital communication " in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 41 recites the limitation " communication " in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-37 and 41-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (US 6,236,981) in view of Biffar (US 5,903,880).

Re. Claim 35, Hill discloses acquiring by a user of digital tokens from the digital tokens issuer and storing the digital tokens [C2 L2 to C4 L44; C5 L15-24, C5 L31-41; C8 L1-L17] in a user's tokens database [Figures 2, 4; col. 11 lines 38-45 – see database], and canceling the used digital tokens, that are being used by the user according to computerized predefined criteria [Figure 10; C8 L18-31; C9 L6-L8, C9 L44-L67; C12-L8-L48; C13 L3-L6].

Hill does not explicitly disclose using digital token issued by a digital token issuer by computerized means, during a digital communication between a user and second party, while the third party is not part of the digital communication issuing the digital tokens and the between the user and the digital token issuer when user uses the service provided by the third party such that there is no exchange of digital token between the user and the third party.

The telephone calling cards are well-known to public, when a purchaser is buying a telephone calling card from a vendor or store, selling the telephone card, the telephone company is not part of communication. Purchaser pays the money to vendor, vendor logs the card is sold and validate it (to prevent from theft). Purchaser picks up any phone (public phone, cell phone, etc) and makes call by using the telephone calling card he/she purchased. Now during the telephone conversation of the caller the vendor who sold (issued) the telephone card is not part of conversation, which is different than old time calling from post office while the post clerk was present. Another example, buying purchases by mail, from a vendor, using cashier's check or money orders. The cashier's checks/money orders are issued by banks and during buying the checks/money orders, the vendor is not part of loop of buying the checks/money orders and during buying items the bank is not in the loop.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Hill and add where the vendors (calling card issuer/vendor – third party) are not part of communication to allow the

buyer (user) to call from any where at any time without presence of the vendor to protect the private conversation private.

However Biffar discloses using digital token issued by a digital token issuer by computerized means, during a digital communication between a user and second party, while the third party is not part of the digital communication issuing the digital tokens and the between the user and the digital token issuer when user uses the service provided by the third party such that there is no exchange of digital token between the user and the third party [Abstract; Figures 1A, 1C, 4, col. 2 lines 9-34; col. 9 lines 4-6; col. 11 line 27 to col. 12 line 30 (digital voucher, dynamic log, reconcile)]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Hill and include using digital token issued by a digital token issuer by computerized means, during a digital communication between a user and second party, while the third party is not part of the digital communication issuing the digital tokens and the between the user and the digital token issuer when user uses the service provided by the third party such that there is no exchange of digital token between the user and the third party, as disclosed by Biffar, to provide an online anonymous payment method for individuals to pay merchant (seller) for purchases or service with vouchers (tokens) anonymously.

Re. Claim 36, Hill discloses wherein the digital tokens can be in different predefined values [C5 L31-L41; C12 L48-L67].

Re. Claim 37, Hill discloses wherein the digital tokens are cryptography protected from fraud [C2 L33-L35, C2 L52-L63].

Re. Claim 41, Hill discloses the user sends to the second party a report including information relating to the digital token used and canceled by the user while using the service for which a payment by digital tokens was required [figure C3 L13-L28; C4 L28-L33; C5 L12-L15; C6 L3-L60],

the second party maintains a database of previous reports relating to digital tokens used in the past, and the report received in step (a) is added to the database [C57-L76];

the second party compares the information received in step (a) with previous reports for the same user (verify) [C6 L33-L50], and if the comparison detects a violation of the rules for the use of digital tokens [C6 L48 to C7 L23], then the second party performs one or more of: stores that information, displays a violation report, reports that to the digital tokens issuer, sends a note to the user of such digital token [C11 L5061; C12 L15-L45].

Hill does not explicitly disclose engaging a digital communication between a user and a second party, where the third party does not take part in the communication and does not participate in any exchange of digital tokens with user. However, Biffar discloses engaging a digital communication between a user and a second party, where the third party does not take part in the communication and does not participate in any exchange of digital tokens with user Abstract; Figures 1A, 1C, 4, col. 2 lines 9-34; col. 9

lines 4-6; col. 11 line 27 to col. 12 line 30 (digital voucher, dynamic log, reconcile)]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Hill and include using digital token issued by a digital token issuer by computerized means, during a digital communication between a user and second party, while the third party is not part of the digital communication issuing the digital tokens and the between the user and the digital token issuer when user uses the service provided by the third party such that there is no exchange of digital token between the user and the third party, as disclosed by Biffar, to provide an online anonymous payment method for individuals to pay merchant (seller) for purchases or service with vouchers (tokens) anonymously.

Re. Claim 42, Hill discloses wherein in step (b) the second party maintains a database of previous reports relating to digital tokens used in the past by the user [C14 L40-L48].

Re. Claim 43, Hill discloses wherein in step (b) the second party maintains a database of previous reports relating to digital tokens used in the past by a plurality of other users [C14 L40-L48; C9 L9-L67].

Re. Claim 44, Hill discloses wherein in step (b) the database of previous reports is being updated to include the latest reports, and the oldest reports are deleted there from [C12 L34-L45; C10 L64 to C11 L7].

Re. Claim 45, Hill disclose wherein in step (d) one of the rules for use of digital tokens is that no digital token is allowed to be used twice (prevent double spending) [C12 L8-L27].

Re. Claims 46-47, neither Hill nor Biffar explicitly discloses wherein in step (d) one of the rules for use of digital tokens is that the serial number of successive digital tokens should be in ascending order, and wherein in step (d) one of the rules for use of digital tokens is that the serial number of issued digital tokens should correspond to a digital document or digital permit issued by third party. However these are business choice and an easy way to administer the used, stolen, lost and damaged digital tokens. For example, American Express issues traveler checks in different denomination values and serial numbers in ascending orders, which are assigned to customer. When customer uses a check and gives it to vendor he/she logs the check number serially in log sheet or in case a check is lost by customer or vendor, it can be reported to American Express by user ID and traveler check serial number which makes it easier for user/vendor as well as American Express to update their list. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify disclosures Hill and Biffar and include serial number of successive tokens should be in ascending order to provide better accounting and management.

Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill and Biffar, as applies to claim 41 above, and further in view of Business wire "Subscriber

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Computing Inc. Installs Real-Time Information System Suite For Douglas

Telecommunications Inc.”, Nov. 19, 1997 (hereinafter Subscriber).

Re. Claims 38-40, neither Hill nor Biffar explicitly discloses wherein the digital tokens can be generated by the user himself according to special and secure digital permit from the digital tokens issuer and according to predefined criteria in different predefined values, wherein the service can be the usage of predefined software package that is in the user's possession, and wherein the service can be the usage of wireless resources or any other digital communication means to another user, while the collecting payment party is not involved in the communication. However, Subscriber discloses these steps [see entire document 3 pages; (licensees) (cellular solution) (software-based prepaid metered billing solution)] to provide license to users (carriers) for using Prepay service. Further software licensing is known, for example, Informix database is licensed to large companies, where they (companies) incorporate Informix database to their product and sell it to others. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures Hill and Biffar, and Subscriber to allow user (carriers) to provide prepaid digital token service in response to competitive issues.

Response to Arguments

4. Applicant's arguments filed 8/27/07 with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Abdi Kambiz can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Primary Examiner
Art Unit 3692

Harish T Dass

11/8/07